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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,809	11/10/2005	Nicholas Russell	034164.002	6771
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EXAMINER ZAHR, ASHRAF A				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/522,809

**Applicant(s)**

RUSSELL, NICHOLAS

**Examiner**

ASHRAF ZAHR

**Art Unit**

2175

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,9-15, 19,31,39-43,50,62-64 and 79-90 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,9-15, 19,31,39-43,50,62-64 and 79-90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/29/2008 has been entered.

### ***Response to Arguments***

2. Applicant Argues, "Neither the Kim nor Slotznick references disclose two-way communication between the recipient's computer and a character server. Neither reference discloses that an animated character can be supplied to the recipient's computer in response to a request by the recipient's computer for a character".

Kim discloses, "server computer 130 (FIG. 4C) maintains local buffers 132A-132N and 132Q to hold data related to corresponding users 20A-20N and 20Q. During operation, computer 120Q may receive a message or mouse movement (or a clickstream of arrow keys) from user 20Q (as illustrated by act 133 in FIG. 4D) and transmit this information to server computer 130 (FIG. 4C). Server computer 130 in turn saves this information in its memory (e.g., in a memory location specific to user 20Q), and supplies the information (as illustrated by act 134 in FIG. 4D) to all users (e.g. to

each of computers 120A-120N that update their respective displays in the normal manner). (Kim, col 12, ln 8-22).

In order for any information to be transferred to the client, it must be requested from the client. This occurs when the client connects to the server or when the client communicates with the server to request more information. Any communication between a client and client or client and server is necessarily two way communication.

Furthermore, Crawford has been cited below to further show that the method described below would have been obvious. Crawford, ¶0088 describes a method by which a client sends identification information to a server to establish a connection with another client. Once the connection is established a buddy icon can be sent that is then accepted or rejected. This same method would be obvious to use in the case of retrieving an avatar.

Finally, In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Therefore, the examiner respectfully disagrees with the applicant.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 19, 43, 64, and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim, US 6,910,186 (Hereinafter, Kim) in view of Crawford, US 2004/0201624 (Hereinafter, Crawford).**

**Regarding Claim 19**, Kim discloses "a method for managing an Instant Messaging system" (Kim, Fig 4C).

Crawford also discloses "including receiving a request in a character server from a computer system of a recipient of an Instant Message (IMI) for an animated character". Specifically, the client 702b sends a connect message to the client 702a through the host 704. The connect message includes, for example, the message type, the screen name of the first subscriber, the screen name of the second subscriber, the IP address of the client 702b, and a randomly generated security number. The host 704 authenticates that the connect message from the client 702b is from a valid subscriber and then sends the connect message to the client 702a. It would be obvious to one of ordinary skill at the time of the invention to use this method to connect to a server and retrieve the characters. The motivation to do so would be so that a server supplies the information to all users (Kim, col 12, ln 15-20).

Kim also discloses "said request including an identification of a sender of the IM to said recipient's computer system, said character server having records of animated

characters and senders, each sender associated with a specific animated character”.

(Kim, Fig 4C, node 132N, col 12, ln 9-23)

Kim also discloses “querying a database in said character server with said identification to identify the animated character associated with sender” (Kim, Fig 4C col 12, ln 9-23).

Kim also discloses “receiving said animated character associated with the sender from said database” (Kim, Fig 4B, col 12, ln 9-23).

Kim also discloses “forwarding said animated character from said character server to said recipient’s computer system” (Kim, Fig 4B, col 12, ln 9-23).

**Regarding Claim 43**, this claim is substantially similar to claim 19 and is therefore rejected based upon the same reasoning used to reject claim 19.

**Regarding Claim 64**, this claim is the apparatus used to perform the method in claim 19. This claim is substantially similar to claim 19 and is therefore rejected based upon the same reasoning used to reject claims 19.

**Regarding Claim 80**, this claims a program storage device readable by a machine” of the method in claim 19. Therefore, this claim is rejected based upon the same reasoning used to reject claim 19.

5. **Claims 1, 9-10, 13-15, 31, 39-40, 50, 62-63, 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slotznick, US 2001/0033298 (Hereinafter, Slotznick) in view of Crawford, US 2004/0201624 (Hereinafter, Crawford) and in further view of Kim, US 6,910,186 (Hereinafter, Kim).**

**Regarding Claim 1**, Slotznick discloses "a method for instant messaging on a recipient's computer system". (Slotznick, Fig 1, ¶0032).

Slotznick also discloses "on the recipient's computer system receiving an instant message (IM) containing content from a sender" (Slotznick, Fig 1, ¶0033).

Slotznick also discloses "displaying said animated character associated with said sender on the recipient's computer system" (Slotznick, Fig 1, ¶0035).

Slotznick also discloses "delivering said content on the recipient's computer system through said animated character" (Slotznick, Fig 1, ¶0035).

Slotznick also discloses, "on the recipient's computer system ,determining an identification of said sender of said IM from said IM" (Slotznick, Fig 1: 118).

Crawford also discloses "sending a request from the recipient's computer system to a character server with said identification of said sender, said character server having records of animated characters and senders, each sender associated with a specific animated character". Specifically, the client 702b sends a connect message to the client 702a through the host 704. The connect message includes, for example, the message type, the screen name of the first subscriber, the screen name of the second subscriber, the IP address of the client 702b, and a randomly generated security number. The host

704 authenticates that the connect message from the client 702b is from a valid subscriber and then sends the connect message to the client 702a. It would be obvious to one of ordinary skill at the time of the invention to use this method to connect to a server and retrieve the characters. The motivation to do so would be so that a server supplies the information to all users (Kim, col 12, ln 15-20).

Kim also discloses "receiving in the recipient's computer system from said character server the animated character associated with said sender". Specifically, a server supplies the information to all users (Kim, col 12, ln 15-20).

It would obvious to one of ordinary skill in the art at the time of the invention to combine the instant messaging system in Slotznick with animated character advertisement in Kim. The motivation for doing so is to increase interactivity with customer (Kim col 8, ln 62-63).

**Regarding Claim 9**, Slotznick discloses all the limitations of "the method of claim 1 above".

Slotznick does not disclose "periodically retrieving advertisement details from a server". Kim remedies this with the disclosure of downloading information from a server (Kim, col 12, ln 9-22). It would obvious to one of ordinary skill in the art at the time of the invention to combine the instant messaging system in Slotznick with animated character advertisement in Kim. The motivation for doing so is to increase interactivity with customer (Kim col 8, ln 62-63).



Slotznick also does not disclose "downloading to the recipient's computer system an animated advertising character specified to represent said advertisement". Kim remedies this with the disclosure of downloading an organizational avatar (Kim, col 8, ln 45-65). It would obvious to one of ordinary skill in the art at the time of the invention to combine the instant messaging system in Slotznick with animated character advertisement in Kim. The motivation for doing so is to increase interactivity with customer (Kim col 8, ln 62-63).

Slotznick also does not disclose "displaying on the recipient's computer system said animated advertising character specified to represent said advertisement". Kim remedies this with the disclosure of using the organizational avatar to advertise cost effectively (Kim, col 8, ln 45-65). It would obvious to one of ordinary skill in the art at the time of the invention to combine the instant messaging system in Slotznick with animated character advertisement in Kim. The motivation for doing so is to increase interactivity with customer (Kim col 8, ln 62-63).

Slotznick also does not disclose "delivering content specified for said advertisement on the recipient's computer system through said animated chracter". Kim remedies this with the disclosure of using the organizational avatar to advertise cost effectively (Kim, col 8, ln 45-65). It would obvious to one of ordinary skill in the art at the time of the invention to combine the instant messaging system in Slotznick with animated character advertisement in Kim. The motivation for doing so is to increase interactivity with customer (Kim col 8, ln 62-63).

**Regarding Claim 10**, Slotznick also discloses “the method of claim 1, further including: sending an alert to a server” (Slotznick, Fig 1).

Slotznick also discloses, “receiving in the recipient’s computer system a response containing content from said server generated by an artificial intelligence (AI) application” (Slotznick, ¶0024).

Slotznick also discloses, “displaying on the recipient’s computer system an animated character associated with said AI application” (Slotznick, Fig 1, ¶0035).

Slotznick also discloses, “delivering said content on the recipient’s computer system through said animated character associated with said AI application”. (Slotznick, Fig 1, ¶0035).

**Regarding Claim 13**, Slotznick does not specifically disclose “the method of claim 1, further including: “associating a sender with a plurality of predefined animated characters” and “allowing the sender to select an animated character from the plurality of predefined animated characters associated with the sender to be displayed on the recipient’s computer system in the event the sender sends an IM message to said recipient’s computer system”. However, Kim remedies this with the disclosure of having the user enter into a contract with the owner of an organizational avatar (Kim, col 9, ln 0-19). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the animated characters in Slotznick with the ability to select a predefined character in Kim. The motivation for combining the two references is that the avatar

would be used to represent live persons in shared user environment (Kim, col 8, ln 48-50).

**Regarding Claim 14**, Slotznick does not specifically disclose "the method of claim 1, further including: initially allowing the sender to upload an image for use in creating a record of an animated character to be displayed on the recipient's computer system when said user sends an IM message to said recipient's computer system". However, Kim remedies this with the disclosure of a generic avatar that could be used to represent a user (Kim, col 8, ln 52-54). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the animated characters in Slotznick with the ability to select an artist created generic avatar in Kim. The motivation for combining the two references is that the avatar would be used to represent live persons in shared user environment (Kim, col 8, ln 48-50).

**Regarding Claim 15**, Slotznick discloses "a method for instant messaging on a recipient's digital communication system, including" (Slotznick, Fig 1, ¶0032).

Slotznick also discloses "receiving on the recipient's digital communication system one or more instant messages (IM) containing content from at least one sender, each at least one sender associated with a specific animated character" (Slotznick, Fig 1, ¶0033).

Slotznick also discloses "delivering said content on the recipient's computer system through said at least one animated character" (Slotznick, Fig 1, ¶0035).

Slotznick also discloses "determining an identification of said at least one sender of one of said IMs from said IM"(Slotznick, Fig 1: 118).

Slotznick does not specifically disclose "forming a queue by creating a dynamic array and inserting an incoming message into said queue". Kim remedies this with the disclosure of a buffer to hold data corresponding to related users (Kim, col 12, ln 9-12). It would be obvious to one of ordinary skill in the art at the time of the invention to combine buffer with the messaging system in Slotznick. The motivation to do so is to assist in the transfer of information (Kim, col 11, ln 65-67).

Slotznick does not specifically disclose "controlling the timing of operations of actions in the queue and when required displaying at least one animated character associated with a respective sender". Kim remedies this by stating the server supplies information to all users that update their respective displays in the normal manner (Kim, col 12, ln 14-19). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the controlling of timing operations to the messaging system in Slotznick. The motivation to do so is to assist in the transfer of information (Kim, col 11, ln 65-67).

Crawford also discloses, "sending a request to a character server with said identification of said sender" Specifically, the client 702b sends a connect message to the client 702a through the host 704. The connect message includes, for example, the message type, the screen name of the first subscriber, the screen name of the second subscriber, the IP address of the client 702b, and a randomly generated security number. The host 704 authenticates that the connect message from the client 702b is

from a valid subscriber and then sends the connect message to the client 702a. It would be obvious to one of ordinary skill at the time of the invention to use this method to connect to a server and retrieve the characters. The motivation to do so is to assist in the transfer of information (Kim, col 11, ln 65-67).

Kim also discloses "receiving from said character server an animated character associated with said sender" Specifically, a server supplies the information to all users (Kim, col 12, ln 15-20). It would be obvious to one of ordinary skill in the art at the time of the invention to combine character server with the messaging system in Slotznick. The motivation to do so is to assist in the transfer of information (Kim, col 11, ln 65-67).

**Regarding Claim 31**, this claim is substantially similar to claim 1 and is therefore rejected based upon the same reasoning used to reject claim 1.

**Regarding Claim 39**, this claim is substantially similar to claim 9 and is therefore rejected based upon the same reasoning used to reject claim 9.

**Regarding Claim 40**, this claim is substantially similar to claim 10 and is therefore rejected based upon the same reasoning used to reject claim 10.

**Regarding Claim 50**, applicant is claiming the apparatus used to perform the method in claim 1. This claim is substantially similar to claim 1 and is therefore rejected based upon the same reasoning used to reject claim 1.

**Regarding Claims 62-63**, applicant is claiming the apparatus used to perform the method in claims 13-14. These claims are substantially similar to claims 13-14 and are therefore rejected based upon the same reasoning used to reject claims 13-14.

**Regarding Claim 79**, this claims a program storage device readable by a machine" of the method in claim 1. Therefore, this claim is rejected based upon the same reasoning used to reject claim 1.

**Regarding Claim 81**, Slotznick also discloses, "the method of claim 1 wherein delivering said content to the recipient's computer system includes: converting text from said IM into audio through text-to-speech synthesis and playing said audio" (Slotznick, ¶0003).

**Regarding Claim 82**, Slotznick also discloses, "the method of claim 81, wherein delivering said content to the recipient's computer system further includes: animating said character in synchronization with said playing of said audio" (Slotznick, ¶0003).

**Regarding Claim 83**, Slotznick also discloses, "the method of claim 82, wherein delivering said content to the recipient's computer system further includes: detecting an emoticon in said IM; and animating said character in a way that reflects an emotion of said emoticon" (Slotznick, ¶0003, 16).

**Regarding Claim 84**, Slotznick also discloses, "the method of claim 1, wherein displaying said animated character includes displaying said animated character outside of an IM window on a screen" (Slotznick, ¶0016)..

**Regarding Claim 85**, Slotznick also discloses, "the method of claim 84, further including enabling said recipient to move said animated character anywhere on the screen" (Slotznick, ¶0016).

**Regarding Claim 86-90**, applicant is claiming the apparatus used to perform the method in claims 81-85. This claim is substantially similar to claims 81-85 and is therefore rejected based upon the same reasoning used to reject claims 81-85.

6. **Claims 11-12, 41 rejected under 35 U.S.C. 103(a) as being unpatentable over Slotznick, US 2001/0033298 (Hereinafter, Slotznick) in view of Crawford, US 2004/0201624 (Hereinafter, Crawford) in further view of Kim, US 6910186 (Hereinafter, Kim) and in further view of Wolton et al., US 2004/0030741 (Hereinafter, Wolton).**

**Regarding Claim 11**, Slotznick and Kim discloses all the limitations of "the method of claim 10".

However, Slotznick does not disclose "sending a message indicating that a web search is to be performed". Wolton remedies this with a disclosure of a boolean search (Wolton, Fig 4).

However, Slotznick also does not disclose "sending keywords to search in said web search". Wolton remedies this with a disclosure of sending search terms (Wolton, ¶0153).

It would be obvious to one of skill in the art to combine the search engine of Wolton with the messaging system of Slotznick. The motivation to do so is where Wolton states the entire search and retrieval agent system provides a digital character representing individual agents (Wolton, ¶0244).

**Regarding Claim 12**, Slotznick and Kim also do not disclose "the method of claim 11, wherein said delivering said content comprises delivering results of said web search". Wolton remedies this with a disclosure of a retrieval system (Wolton, ¶244). It would be obvious to one of skill in the art to combine the search engine of Wolton with the messaging system of Slotznick. The motivation to do so is where Wolton states the entire search and retrieval agent system provides a digital character representing individual agents (Wolton, ¶0244).

**Regarding Claim 41**, this claim is substantially similar to claim 11 and is therefore rejected based upon the same reasoning used to reject claim 11.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHRAF ZAHR whose telephone number is (571)270-1973. The examiner can normally be reached on M-F 9:30 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Bashore can be reached on (571)272-4088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAZ 12/30/2008

/WILLIAM L. BASHORE/  
Supervisory Patent Examiner, Art Unit 2175